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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/472,662 12/27/99 HAMMERMAN

M A-68752-1/RF

EXAMINER

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HM12/0309

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ART UNIT	PAPER NUMBER
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1653

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**DATE MAILED:**

03/09/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

**Office Action Summary**

Application No. <b>09/472,662</b>	Applicant(s) <b>Hammerman</b>
Examiner <b>F. T. Moezie</b>	Group Art Unit <b>1653</b>

 Responsive to communication(s) filed on Dec 27, 1999 This action is **FINAL**. Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire one month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

**Disposition of Claims** Claim(s) 1-12 is/are pending in the application.

Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

 Claim(s) \_\_\_\_\_ is/are allowed. Claim(s) \_\_\_\_\_ is/are rejected. Claim(s) \_\_\_\_\_ is/are objected to. Claims 1-12 are subject to restriction or election requirement.**Application Papers** See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948. The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner. The proposed drawing correction, filed on \_\_\_\_\_ is  approved  disapproved. The specification is objected to by the Examiner. The oath or declaration is objected to by the Examiner.**Priority under 35 U.S.C. § 119** Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

All  Some\*  None of the CERTIFIED copies of the priority documents have been

received.

received in Application No. (Series Code/Serial Number) \_\_\_\_\_.

received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\*Certified copies not received: \_\_\_\_\_

 Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).**Attachment(s)** Notice of References Cited, PTO-892 Information Disclosure Statement(s), PTO-1449, Paper No(s). \_\_\_\_\_ Interview Summary, PTO-413 Notice of Draftsperson's Patent Drawing Review, PTO-948 Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

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## **DETAILED ACTION**

### **STATUS OF CLAIMS**

Claims 1-12 are pending in this application file.

### **RESTRICTION REQUIREMENT**

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1 and 2, drawn to an isolated embryonic metanephric tissue, classified in class 128, subclass depending on the suitable stage and conditions.
- II. Claims 3-10, drawn to embryonic metanephric tissue which has been pretreated and a method for the treatment of embryonic metanephric tissue, classified in class 514, subclass depending on the growth factor used..

The inventions are distinct, each from the other because:

Inventions I and II are distinct one from the other. Inventions are distinct because they have different objectives, different modes of operation and different functions. A reference which would render obvious claims drawn to one of the inventions under 35 USC 103 (a) may not obviate claims drawn to the other invention - absent ancillary evidence. Moreover, the computer and library searches are not coextensive. It would be an undue burden to examine both inventions in one application.

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Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter, restriction for examination purposes as indicated is proper.

Upon finding of allowable subject matter in the elected invention(s), examiner will consider a rejoinder of claims drawn to a composition, rewritten commensurate in scope with the allowable claims.

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

#### **ELECTION OF SPECIES**

Applicant is required under 35 U.S.C. 121 to elect a single disclosed species of growth factor as cited in any of claims 2, 4, 6 or 12 for prosecution on the merits.

Applicant is advised that a reply to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

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Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

**Applicant is advised that the reply to this requirement to be complete must include an election of the invention together with an election of the specie(s) of growth factor to be examined even though the requirement be traversed (37 CFR 1.143).**

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(I).

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to F.T. Moezie whose telephone number is (703) 305-4508.

F. T. Moezie  
MOEZIE, F.T.  
PRIMARY EXAMINER  
ART UNIT 1653  
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